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EXAMINER

YIP, WINNIE S

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/613,946  
Filing Date: July 07, 2003  
Appellant(s): CONNELLY, KEVIN T.

**MAILED**

AUG 01 2007

**GROUP 3600**

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Werner H. Schroeder  
For Appellant

**EXAMINER'S ANSWER**

The previous Examiner's Answer is **VACATED** and **REPLACED** with this Examiner's Answer, which corrects the U.S. Patent Number from **4,979,534** to **5,487,401** to the Johnson et al. reference in the section number **(8) Evidence Relied Upon**.

This is in response to the appeal brief filed February 21, 2007 appealing from the Office action mailed June 8, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,487,401	Johnson et al.	01-1996
5,678,587	Bilotti	10-1997

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5,890,506	Kupferman	4-1999
6,378,539	Allee	4-2002

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US Patent NO. 5,487,401) in view of Kupferman (US Patent No. 5,890,506) and in view of Bilotti (US Patent No. 5,678,587).

Johnson et al. teaches a shade and rain umbrella combination including a base umbrella having a shaft (14) and ribs (18) pivotally mounted on a top of the shaft, a shade cover (20) placed over the ribs and fastened to its peripheral points (24) at ends (28) of ribs, the shade cover (20) being made of water-resistant material for against sunshine that inherently providing a protection against a certain amount of ultraviolet rays of the sun, and at the same time the shade cover having vent holes (34) for allowing ventilation air to pass through, and a separated water proof rain cover (36) being placed over and connected to the shade cover by fastening means (i.e., 48, 66) for protection of raining, wherein the rain cover (36) has a size would be substantially same as the shade cover (see Figs. 1 or 14), the rain cover (36) having a plurality of strips (48) disposed along a peripheral of the rain cover, each strip has an eyelet/grommet (52) with a hole (50) being slipped over a respective free end of the rib (18) to provide means for fastening the rain cover to the peripheral points at each ends of the ribs such that the rain cover can be added in the event of rain and removed in sunshine, and the rain cover (36) including a central hole (40) having a grommet (42) being snugly fitted to an upper end portion (32) on the top of the shaft.

Although Johnson et al. does not define the shade cover being made of fabric mesh material for protection against ultraviolet rays of the sun as claimed, Kupferman teaches a shade and rain umbrella combination comprising a shade cover (22) being covered by a rain cover (24), wherein the shade cover (22) consists

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an area (34) being made of woven mesh fabric (32) for allowing ventilation air passed there through and the rain cover (24) covering the mesh portion for preventing the rain into the mesh portion when used in raining. And, further Bilotti teaches an umbrella formed with a shape cover (46) supported by ribs, and the shade cover (46) being made of woven mesh fabric coated with ultraviolet protecting material to against the rays of the sun (see col. 4, lines 18-20). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the combined umbrella of Johnson, et al. including a basic umbrella having a shade cover having at least a portion being formed or covered by a woven mesh fabric for allowing air transmitted there through the shade cover as taught by Kupferman and the woven mesh fabric material being coated with a layer of ultraviolet blocking material for highly against ultraviolet rays from the sun as taught by Bilotti for providing a combined umbrella including a base umbrella having a shade cover being made of fabric mesh material with a layer of ultraviolet rays protecting coating for highly against ultraviolet rays of the sun while to provide a larger covered area allowing ventilation air passed there through when used in sunshine. The umbrella of Johnson et al. as combined with Kupferman and Bilotti would be performed equally well with a shade cover being made specifically of woven mesh fabric sheet as claimed to take the advantage properties of air transmissible since such material are flexible and easily conformable in shape with the cover according to technology and having lightweight, weather and air transmissible characterizes as common used in shade cover art. All of the foregoing is within the skills, competence and knowledge of the person with ordinary skills in the covering art.

2. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, et al. '401 in view of Kupferman '506 and Bilotti '587 and as applied to claim 1 above, and further in view of Allee (US Patent No. 6,378,539).

The claims are considered to meet by Johnson et al. modified by Kupferman and Bilotti as explained and applied set forth above rejections except that neither of Johnson et al. nor Kupferman nor Bilotti defines the umbrella combination including means for clamping the shaft in an upright position on a support. However, Johnson et al. further teach the umbrella having a handle (12) that would be modified in various configuration such as the handle (12) may formed with variety configurations form attaching to another structure (see Fig. 16 and 20). In addition, Allee teaches an umbrella (1) comprising a shaft (5), a clamping device providing means for clamping the shaft in an upright position on an support device (9), wherein the clamping device (7') having a C-shaped clamp (33 or 83) providing thread holes (80 and 21' or 99) for receiving the end of the shaft (3) in two different directions. It would have been obvious to one ordinary skill in the art, at the time the invention was made, to modify the umbrella combination of Johnson et al. having covers formed by material as taught by Kupferman and Bilotti and having the handle of the umbrella being modified with a clamping device for clamping the handle of the umbrella in two different orientations as taught by Allee for mounting the shaft of the umbrella in an upright position disposed on different oriented support surfaces.

#### **(10) Response to Argument**

**1. In response to appellant's argument with respect the rejection of claims 1 and 4.**

In response to appellant's argument that Johnson is entire different concept and construction, examine disagreed. First, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In is case, according to the specification, appellant discloses the claimed invention is a base umbrella used under a sunshade and having a rain proof cover added thereon for covering the based umbrella in raining. As

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discussed above rejection, Johnson et al. teaches a base umbrella (10) being used under a sunshade with a shade cover being made of material that is used to against the sunshine and at the same time has vent holes (34) thereon for allowing air passed through the cover to provide an umbrella with ventilation area while under the sun, and having a rain proof cover (36) added thereon for covering the base umbrella in various purposes including in raining. Wherein the vent holes of the shade cover of Johnson et al. provide a same function as the holes of a mesh material for allowing air passed through the material as claimed. Therefore, Johnson et al. are considered to teach a same concept as claimed invention.

Second, we agreed that Johnson does not define the shade cove (20) being made of mesh material, otherwise our rejection would have been entered under section of U.S.C. 102 of statute but not based on 103(a) rejection as now. Kupferman and Bilotti are used as references to teach a base umbrella is known being made of mesh material for shading under sun while allowing air passed through.

In response to appellant's argument that Johnson's cover is not a rain proof cover because it includes opening 44, examiner disagreed. First, Johnson et al. teaches a base shade cover having openings (34) to provide means for allowing ventilation air to pass through the fabric while used under sunshine such that the shade cover is functionally equivalent to a mesh material for allowing air passed through. Johnson et al. then teaches the upper cover (36) being made of **elastic material and "water-resistant material"** (see col. 6, line 10) and being placed over the base shade cover (20). The upper cover (36) of Johnson et al. is considered to be "substantially" the same size as the base shade cover (see Fig. 4), and those openings (44) of the upper cover may be completely closed by flaps (70) after placed over the shade cover (see Fig. 4), and the

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upper cover is then used to cover the openings of the lower shade cover to **prevent rain** from entering the vent holes (col. 2, lines 58-62), therefore, Johnson et al. is considered to teach the upper cover being a “rain cover” as claimed. Appellant does not claim the “shade cover” being entirely made of mesh material.

In response to appellant’s argument that Johnson does not teach the rain cover being connected to the peripheral points of the ribs as claimed, it is not persuasive. As discussed above rejection, Johnson et al. clearly shows and teaches the rain cover (36) “is secured to the free ends or tips (28) of the ribs (18)” (see col. 7, lines 10-11). Johnson et al. also teach each rain cover having a strip (50) having a grommet (52) being slipped over a respective free end of the rib (18). Therefore, the rain cover of Johnson et al. is considered being connected to the peripheral point of the ribs and supported over the base shade cover as claimed.

**2. In response to appellant’s argument with respect to the rejection to claims 9-10.**

In response aappellant’s argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, first, claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, et al. in view of Kupferman and Bilotti as applied to claim 1 as discussed above, and further in view of Allee for modify the combined umbrella of Johnson and Kupferman and



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Bilotti to have means for clamping the shaft of the umbrella on an object. Therefore, to discuss the modification of the mesh material of the base cover as combined references of Bilotti and Kupferman with Johnson to claims 9-10 is irrelevant.

Beside, in addition to response to appellant's argument that there is no suggestion to combine the Johnson umbrella by incorporating the mesh fabric of Kupferman and the mesh fabric being coated to prevent ultraviolet rays from the sun as further taught by Bilotti, it is not persuasive. We note that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggesting, or motivation to do so found either in the reference or in the knowledge generally available to one of ordinary skill in the art. In this case, all references are in the same umbrella art. As discussed above rejection, Johnson et al. and Kupferman and Bilotti teach a shade umbrella with additional a cover in combination. Kupferman is used to teach the benefits of the shade cover being made of a woven mesh fabric material for the solving the same problem of allowing air passed through as the claimed invention. And Bilotti is used only to teach the woven mesh fabric material could be coated with a UV protecting material to provide high protection against UV rays of the sun as claimed. Although, appellant does not positively claims the mesh material including what specific material that provide protection to UV rays, and it is a common practice that any shade cover may block certain amount of UV rays form the sun. Hence, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify an umbrella of Johnson et al. to have the base umbrella cover being made of mesh material with a UV protection coating as taught by Kupferman and Bilotti to achieve obvious result of allowing more air passed through while under sunshine as claimed invention

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since it has been held that a mere of essential of choice of a material involves only routine skill in the art. And, a prima facie case of obviousness has been established.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted.



Winnie Yip  
Primary Examiner  
Art Unit 3636

Conferees:

David Dunn   
Meredith Petravick 